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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,987	10/12/2001	Raymond Clarke	10621-3	4161

7590 02/23/2006
Sheldon & Mak
9th Floor
225 South Lake Avenue
Pasadena, CA 91101

EXAMINER

RHEE, JANE J

ART UNIT PAPER NUMBER

1745

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,987

Applicant(s)

CLARKE ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13, 15, 16, 20, 23-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-77 is/are rejected.
- 7) ☒ Claim(s) 1-8, 13, 15, 16, 20, 23-25, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Repeated

1. The objection under 35 U.S.C. 132(a) to the specification has been repeated for the reasons previously made in office action 9/8/2005.
2. The 35 U.S.C. 112 first paragraph of claims 36-77 has been repeated for the reasons previously made in office action 9/8/2005.

Response to Arguments

3. Applicant's arguments filed 12/8/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the passage on page 2 lines 15-22 support the amendment to the specification of "the membrane optionally has a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3", a statement merely stating generally to the change in O2 permeability with temperature does not give support to the specification that that membrane optionally has a P10 ratio. As applicant amended the specification to state that the membrane optionally has a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3, applicant has made the notion that the membrane may not have a P10 ratio measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3. Therefore, unless otherwise specified that the membrane does not have a P10 ratio measured at pressure of 0.035kg per square centimeter over at

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least one 10C range between -5 and 15C of at least 1.3, then the term "optionally" raises new matter issues concerning the properties of the membrane.

In response to applicant's argument that in the second passage on page 10 lines 10-15 of the specification to support the amendment of the specification "the membrane optionally has a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3", applicant argues that the P10 ratio of at least 1.3 is merely preferred and that such P10 ratio is not essential, however the passage does not give support that the P10 ratio is optional. When stating that the membrane optionally has a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3, applicant is introducing the possibility that the membrane does not have a P10 ratio measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3. Applicant is broadening the scope of the specification without broadening the scope of the claim.

In response to applicant's argument for the third, fourth and fifth passages used as support for the amendment to the specification pointed out in the argument section dealing with crystalline and non crystalline polymers, the passages do not give support that the membrane optionally has a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3. As discussed above, the specification did not have prior support for the exclusion of the membrane with a P10 ratio measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3. Mere preference of a

P10 ratio does not support the exclusion of one P10 ratio. Furthermore, the term “optionally” does not positively state that the membranes has a P10 ratio.

In response to applicant’s argument that there is a clear basis for the statement that the control section may provide “at least the principal pathways” on page 2 lines 22-25, examiner does not argue that there is clear basis for the limitation “at least the principal pathways”, but argues that the control sections “optionally substantially the only pathways for oxygen and carbon dioxide to enter or leave the packaging atmosphere” has no support in the original specification. With this amendment, applicant is stating that the principal pathways are not the only pathway for oxygen and carbon dioxide to enter or leave the packaging atmosphere. The original specification stated that the principal pathways were substantially the only pathways for oxygen and carbon dioxide to enter or leave the packaging atmosphere.

In response to applicant’s argument that its common to have certain independent claims to have an optional feature and other independent claims not to have an optional feature therefore deleting the limitation “a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between –5 and 15C of at least 1.3” do not fail to support claim 1, the specification as newly amended states that the P10 ratio measured at pressure of 0.035kg per square centimeter over at least one 10C range between –5 and 15C of at least 1.3 is optional therefore can state that a membrane does not have a P10 ratio measured at pressure of 0.035kg per square centimeter over at least one 10C range between –5 and 15C of at least 1.3 creating a lack of support to the limitation in claim 1.

In response to applicant's argument concerning the 112 first paragraph rejection, applicant argues that every gas permeable membrane inherently has a P10 ratio over any specified 10C range therefore is enabled for the deletion of the P10 ratio property in claims 36-77, however original specification does not state that this P10 ratio is an inherent property but that the properties of the membrane depend on many factors such as base film, coating polymer, coating composition and the amount of coating applied to the base film (specification page 10 lines 10-14). Therefore, a deletion of a P10 ratio, measured at pressure of 0.035kg per square centimeter over at least one 10C range between -5 and 15C of at least 1.3 does not enable the practice of the invention because the original specification stated the coating polymer should be selected so that the membrane has a desired P10 ratio and a desired R ratio, and should be coated onto the microporous film at a coating weight which results in a membrane having the desired balance between the permeability characteristics (specification page 5 first paragraph). Thus, the deletion of the P10 ratio does not permit the selection of the coating polymer which is essential to the practice of the invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

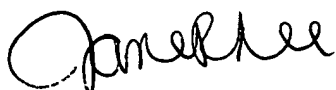
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
February 10, 2006



PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER